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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/294,539 04/19/99 MAW SHENO

C 23070-948

020350 HM12/0529  
TOWNSEND AND TOWNSEND AND CREW  
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EXAMINER

KUBELIK, A

ART UNIT

PAPER NUMBER

1638

DATE MAILED:

05/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/294,539

Applicant(s)

MAW SHENQ ET AL.

Examiner

Anne Kubelik

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1638

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 April 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-69 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

*Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, 12, 21, 30-33, 42, 51 and 60-61, drawn to a nucleic acid encoding SEQ ID NO:2, plants transformed with that nucleic acid and a method of enhancing resistance to pathogens, classified in class 536, subclass 23.6, for example.
- II. Claims 1-2, 4, 13, 22, 30-32, 34, 43, 52, 60 and 62, drawn to a nucleic acid encoding SEQ ID NO:4, plants transformed with that nucleic acid and a method of enhancing resistance to pathogens, classified in class 800, subclass 279, for example.
- III. Claims 1-2, 5, 14, 23, 30-32, 35, 44, 53, 60 and 63, drawn to a nucleic acid encoding SEQ ID NO:6, plants transformed with that nucleic acid and a method of enhancing resistance to pathogens, classified in class 800, subclass 301, for example.
- IV. Claims 1-2, 6, 15, 24, 30-32, 36, 45, 54, 60 and 64, drawn to a nucleic acid encoding SEQ ID NO:8, plants transformed with that nucleic acid and a method of enhancing resistance to pathogens, classified in class 800, subclass 320.2, for example.
- V. Claims 1-2, 7, 16, 25, 30-32, 37, 46, 55, 60 and 65, drawn to a nucleic acid encoding SEQ ID NO:10, plants transformed with that nucleic acid and a method of enhancing resistance to pathogens, classified in class 435, subclass 418, for example.

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- VI. Claims 1-2, 8, 17, 26,30-32, 38, 47, 56, 60 and 66, drawn to a nucleic acid encoding SEQ ID NO:12, plants transformed with that nucleic acid and a method of enhancing resistance to pathogens, classified in class 435, subclass 419, for example.
- VII. Claims 1-2, 9, 18, 27, 30-32, 39, 48, 57, 60 and 67, drawn to a nucleic acid encoding SEQ ID NO:14, plants transformed with that nucleic acid and a method of enhancing resistance to pathogens, classified in class 800, subclass 278, for example.
- VII. Claims 1-2, 10, 19, 28, 30-32, 40, 49, 58, 60 and 68, drawn to a nucleic acid encoding SEQ ID NO:16, plants transformed with that nucleic acid and a method of enhancing resistance to pathogens, classified in class 800, subclass 298, for example.
- IX. Claims 1-2, 11, 20, 29-32, 41, 50, 59-60 and 69, drawn to a nucleic acid encoding SEQ ID NO:18, plants transformed with that nucleic acid and a method of enhancing resistance to pathogens, classified in class 435, subclass 468, for example.

Claims 1-2, 30-32 and 60 are generic and will be examined to the extent they read on the elected invention.

The inventions are distinct, each from the other because:

Inventions I-IX are unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the

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different inventions have different modes of operation, different functions, and different effects.

Applicant is reminded that nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C.

121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq (see MPEP 803.04 and 2434). This requirement is not to be construed as a requirement for an election of species, since each nucleotide sequence is not a member of single genus of invention, but constitutes an independent and patentably distinct invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, fields of search, and classification, restriction for examination purposes as indicated is proper. Additionally, a search on more than one sequence is a severe burden on PTO resources.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (703) 308-5059.

The examiner can normally be reached on Monday through Friday, 8:15 am - 4:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula K. Hutzell, can be reached on (703) 308-4310. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Anne R Kubelik  
May 25, 2001

A handwritten signature in black ink, appearing to read "Amy Nelson".

**AMY J. NELSON, PH.D**  
**PRIMARY EXAMINER**